REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and the following commentary.

I. Status of the Claims

Claim 73 was previously cancelled. No claim amendments are made in this response. Claims 1-72 are pending, with claims 26-49 withdrawn from examination.

II. Summary of the Prosecution History

To date, Applicants have filed two RCEs (on April 3, 2008 and January 15, 2009) and received five Office Actions dated January 26, 2007 (non-final), September 20, 2007 (final), May 2, 2008 (non-final), October 14, 2008 (final) and April 6, 2009 (non-final), in the present application. In the present Office Action, the Examiner for the first time imposes a restriction requirement and for the first time relies on a reference previously cited in an IDS submitted on July 16, 2004 to substantiate the rejection under 35 U.S.C. §103(a).

A. Time for Making a Restriction Requirement

In the present application, the Examiner requires Applicants to elect between product claims and process claims, both of which were presented at the filing time. MPEP 811 is excerpted below (emphasis added):

> *37 CFR 1.142(a), second sentence, indicates that a restriction requirement "will normally be made **before any action upon the merits**; however, it may be made at any time **before final action**." This means the examiner should make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as the need for a proper requirement develops.*
>
> *Before making a restriction requirement after the first action on the merits, **the examiner will consider whether there will be a serious burden if restriction is not required**.*

In the present instance, Applicants have received two final Office Actions, dated September 20, 2007 and October 14, 2008, before receiving the restriction requirement. Because both product claims and method claims were submitted at the time of filing, the need for a restriction requirement did not develop during the course of prosecution. The MPEP further guides that the examiner should consider whether there will be a serious burden if restriction is not required if the restriction requirement is to be issued at a later stage of prosecution. Accordingly, the time for making a restriction requirement is improper.

B. Repetitive Rejection Rationale

The primary reference by Bosch, which is relied on for the rejections under 35 U.S.C. §103(a) in the outstanding Office Action, was previously cited by Applicants in an IDS and was considered and initialed by the Examiner on January 19, 2007. However, this is the first time that the pending claims are rejected over Bosch.

Furthermore, the rejection rationale under 35 U.S.C. §103(a) in the outstanding Office Action is essentially the same as that provided in the final Office Action dated September 20, 2007, with the exception that a different set of references was cited.

Specifically, in the present Office Action, the Examiner cites Bosch for the alleged teaching of nanoparticulate drug substances and relies on the secondary references by Plachetka and Struengmann to remedy the acknowledged deficiency of Bosch, i.e., lack of explicit teaching of meloxicam. Similarly, in the final Office Action dated September 20, 2007, the Examiner cited Liversidge or Ryde, which allegedly taught nanoparticulate active agent compositions but failed to teach the claimed meloxicam. The Examiner turned to the secondary reference by Meyer to bridge the gap between the teachings of Liversidge and Ryde and the claimed invention. Applicants submitted arguments and a declaration executed by Dr. Simon McGurk and successfully overcame the rejections advanced in the final Office Action dated September 20, 2007.

Pursuant to MPEP 707.07(g), "[p]iecemeal examination should be avoided as much as possible," and "[t]he examiner ordinarily should...avoid...undue multiplication of references." The rejection in the present Office Action does not resolve the ultimate question of patentability because it repeats the previous, overcome rejections. Accordingly, Applicants urge the Examiner give full consideration to the entire prosecution history, including all evidence on the record, and expedite the examination process.

III. Response to the Restriction Requirement

The pending claims are restricted into two groups: Group I (claims 1-25 and 50-72) drawn to a nanoparticulate composition, and Group II (claims 26-49) drawn to a method for preparing the nanoparticulate composition.

In response to the restriction requirement, Applicants elect Group I, claims 1-25 and 50-72, for examination on the merits, with traverse. Applicants traverse on the grounds that search and examination of the two Groups of claims is not unduly burdensome to the Examiner, and that the restriction requirement is improper at this stage of prosecution (see the above section). Applicants reserve the right to seek rejoinder of the process claims upon allowance of the composition claims.

IV. Rejection of Claims under 35 U.S.C. §103(a)

A. Bosch and Plachetka or Stuengmann

Claims 1-17, 26-29, 31-42 and 50-67 are rejected under 35 U.S.C. §103(a) for alleged obviousness over U.S. Patent No. 5,510,118 to Bosch et al. ("Bosch") in view of U.S. Patent No. 6,479,551 to Plachetka et al. ("Plachetka") or PCT Publication No. WO 99/09988 by Struengmann et al. ("Struengmann"). Applicants respectfully traverse the rejection.

(i) Lack of Any Reason to Select Meloxicam

Bosch describes a process of preparing nanoparticulate drug substances but fails to explicitly disclose the active agent of the claimed invention, meloxicam. The Examiner acknowledges the deficiency of Bosch but relies on Plachetka or Struengmann for the alleged teaching of meloxicam, the claimed species.

MPEP 2144.08 sets forth the guidelines for the Examiner to determine whether one of ordinary skill in the art would have been motivated to select the claimed species. Specifically, the MPEP requires the Examiner to consider the following aspects, where applicable:

(a) consider the size of the genus;

(b) consider the express teachings:

(c) consider the teachings of structural similarity;

(d) consider the teachings of similar properties or uses;

(e) consider the predictability of the technology; and

(f) consider any other teaching to support the selection of the species or subgenus.

Concerning point (a), Bosch describes a genus of drug substances encompassing over 40 categories of drugs and each drug category comprises an enormous number of members. First, Bosch lacks any suggestion to preferentially select analgesics or anti-inflammatory agents out of over 40 categories of the drugs. Second, anti-inflammatory agents encompass a large family of

drugs, including steroidal anti-inflammatory drugs and non-steroidal anti-inflammatory drugs. A quick search of the drug bank using the keyword "anti-inflammatory drugs" returned 767 entries.

In relation to point (b), Plachetka discloses 17 NSAIDs, including meloxicam, and teaches that naproxen is the most preferred NSAID. *See* column 2, line 62, through column 3, line 1, and column 3, lines 56-60. Struengmann merely discloses new meloxicam compositions. In the absence of any express teaching of selecting an anti-inflammatory agent or an analgesic, and among the anti-inflammatory agents and analgesics, selecting meloxicam, given the disclosure of Bosch one skilled in the art would not have selected meloxicam, in view of Plachetka or Stuengmann, as the active agent to obtain the claimed composition.

Turning to points (c) and (d), the over 40 categories of drugs described by Bosch do not share structural similarity or have similar properties or uses.

In the absence of any guidance from the cited art to select the particular active agent of the claimed composition, the Examiner has fallen into the trap of hindsight distortion, *i.e.*, breaking the claims down to their component elements, searching for each element in the prior art, and then putting the elements back together using Applicants' claims as a road map. As such, it is only by the improper reliance on this impermissible hindsight that the Examiner identified the specific elements in the references and formulated the combination of the elements necessary to obtain the claimed composition. *See Ortho-McNeil Pharmaceutical Inc., v. Mylan* (Fed. Cir. 2008) at 10 ("[i]n other words, Mylan's expert, Dr. Anderson, simply retraced the path of the inventor with hindsight, discounted the number and complexity of the alternatives, and concluded that the invention of topiramate was obvious. Of course this reasoning is always inappropriate for an obviousness test based on the language of Title 35…").

In view of the foregoing, the Examiner has failed to establish a *prima facie* case of obviousness because the articulated rejection lacks valid support in the cited art.

(ii) Improper Reliance on Inherency

The Examiner contends that the claimed feature "wherein in comparative pharmacokinetic testing with a non-nanoparticulate formulation of meloxicam having the same dosage strength and form, the composition exhibits a shorter time to T_{max} when compared to the time to T_{max} of the non-nanoparticulate meloxicam formulation" is inherent. The rationale in support of the Examiner's conclusion that the T_{max} feature is inherent (which Applicants infer from the requirement to elect a species of method to produce the claimed composition) appears to be that because the claimed product is produced by a process substantially identical to that of applied art, i.e., Bosch, then any drug composition produced by the process in Bosch will have the same features as is now claimed by Applicants (i.e., a shorter time to T_{max} when compared to the time to T_{max} of the non-nanoparticulate formulation of the same drug.) In other words, the Examiner's rationale rests with the theory that identical processes produce products having identical features.

The Examiner's rationale outlined above is not a valid basis for supporting a rejection based on inherency. Nowhere in the MPEP do Applicants find guidance that the above is a valid rationale to support a rejection based on inherency.

Rather, pursuant to MPEP 2112.01(II), the prerequisite for invoking the "inherency" rationale for a composition claim is that the Examiner must identify a reference teaching a ***product which is identical*** to the claimed product. With this proper analysis in mind, the Examiner's application of "inherency" contradicts with her own position that Bosch (or the secondary references) does not explicitly disclose the claimed meloxicam or teach the T_{max} and C_{max} release profile. In other words, the Examiner has not established that Bosch (or the secondary references) teaches an ***identical product*** as the claimed product, i.e., a nanoparticulate meloxicam composition, and therefore, the Examiner has not met the initial burden of making

clear that the allegedly inherent properties (the claimed T_{max}) will ***necessarily*** flow from the disclosure of the cited reference.

Finally, it is an incorrect application of the law to say that the combined teachings of the prior art teach an identical product. None of the rejections in the cited case law in the MPEP use multiple references. Rather, the art cited is a single reference (a 102/103(a) rejection) based upon an argument that the one reference discloses all the claimed elements except for that element which is alleged to be inherent. This is in contrast to the present rejection where, but for the Examiner's combination of multiple references, the ***identical product*** (expect for the alleged inherent feature) does not exist in a single prior art reference. In other words, the identical product only exists as a construct of the Examiner using Applicants' claims as a roadmap. If an identical product doesn't exist in the prior art, then it is illogical that Applicant's claimed feature would necessarily flow from the combination of references made by the Examiner.

Again, this rejection rationale is similar to that of the final Office Action dated September 20, 2007; which Applicants have overcome. Therefore, Applicants' arguments presented in the response filed on January 22, 2008, at pages 33-36, are incorporated by reference.

In view of the foregoing, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. §103(a).

B. Bosch and Desai or Courteille

Claims 18-25, 43-49 and 68-72 are rejected under 35 U.S.C. §103(a) for alleged obviousness over Bosch in view of PCT Publication No. WO 01/45706 by Desai et al. ("Desai") or U.S. Patent No. 5,384,124 to Courteille et al. ("Courteille"). Applicants respectfully traverse the rejection.

Bosch is discussed *supra*. Desai and Courteille are cited for the alleged teaching of a second particle population but fail to compensate for the deficiencies of Bosch as stated above. Moreover, claims 18-25, 43-49 and 68-73 are non-obvious for depending either directly or indirectly from a non-obvious base claim, claim 1. Withdrawal of the rejection is respectfully requested.

C. Bosch and Stainmesse

Claim 30 is rejected under 35 U.S.C. §103(a) for alleged obviousness over Bosch in view of U.S. Patent No. 5,133,908 to Stainmesse et al. ("Stainmesse"). Applicants respectfully traverse the rejection.

Bosch is discussed *supra*. Stainmesse is cited for the alleged teaching of dissolving the active agent in a solvent but fail to compensate for the deficiencies of Bosch as stated above. Moreover, claim 30 is non-obvious for depending indirectly from a non-obvious base claim, claim 1. Withdrawal of the rejection is respectfully requested.

CONCLUSION

The present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date June 29, 2009 By _____

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